

## REMARKS

Claims 1 through 10 are pending in the subject patent application. Claims 5, 6, and 7 have been allowed. Claims 1 through 4, 8, 9, and 10 have been rejected.

### Discussion of Rejections under 35 U.S.C. §103

Claims 1 through 4, 8, 9, and 10 have been rejected under 35 U.S.C. §103 as being unpatentable over Jenkins in view of Liady. Among other things, the Examiner contends that Jenkins discloses a cutter knife 12 adapted to fasten to a longitudinal member W external to a tubular conduit S, in a fixed longitudinal position relative to the external longitudinal member W. In making this contention, the Examiner further states that the member W is “wrapped” around the cutter knife 12, and that this constitutes attachment between the two members.

The Applicants respectfully submit that Jenkins fails to disclose these features cited by the Examiner. Jenkins in fact discloses at column 7, lines 45 through 58, that there is a cyclical rotating and brushing of the cutter knife 12 against the member W, followed by “releasing” of the member W. That is, the cutter knife 12 only brushes against the member W; there is no fastening thereto. The use of the term “wrapped” in Jenkins only describes the curved shape of the cable W as it cyclically lies across the surface of the rotating cutter knife 12, which is followed by cyclical loss of all contact between the cutter knife 12 and the cable W. See Figures 5A through 5C and 6A through 6C. In fact, if there were any actual fastening between the cutter knife 12 and the cable W, no relative movement could occur between the two, and the cutter knife 12 could not abrade the cable W, which is the sole purpose of the Jenkins design. Therefore, any fastening between these two members would render the Jenkins device inoperable.

Further, there is no fixed longitudinal relationship between the cutter knife 12 and the member W. At column 6, lines 53 through 64, Jenkins describes lowering the cutter knife 12 relative to the cable W. Also, at column 7, lines 59 through 67, Jenkins describes an optional longitudinal movement of the cutter knife 12 relative to the cable W, which can be employed to abrade the cable W with the cutter knife 12, as an alternative to the aforementioned rotational abrasion.

Therefore, Jenkins fails to disclose two features recited in claims 1 and 8: (1) the cutter knife 12 is not fastened to the cable W, and (2) the cutter knife 12 does not have a fixed longitudinal position relative to the cable W.

The Examiner further contends that Liady discloses a cutter knife 16 adapted to fasten to a longitudinal member “a” external to the tubular conduit. The Examiner also contends that a surface 5 is oriented to slidingly abut the cutter knife 16 and to force the cutter knife 16 through the external longitudinal member “a” upon lifting of the cutter body 1.

The Applicants respectfully submit that Liady fails to disclose features recited in claims 1 and 8. Liady in fact discloses, at lines 88 through 93, lowering the cutting tool into the well along the member “a”, until the tool strikes the line socket “b” at the lower end of the member “a”. Therefore, like Jenkins, Liady fails to disclose fastening of the cutter to the longitudinal member in a fixed longitudinal position relative to the longitudinal member, as recited in claims 1 and 8.

Further, in Liady, the cutter knife 16 is forced through the member “a” as the cutter body 1 is forced downwardly relative to the cutter knife 16, rather than as the cutter body is lifted relative to the cutter knife, as recited in claims 1 and 8. See Figures 6 and 7. In other words, the cutting occurs as the cutter knife 16 moves upwardly relative to the cutter body 1, rather than as the cutter body moves upwardly relative to the cutter knife.

Therefore, Liady fails to disclose two features recited in claims 1 and 8: (1) the cutter knife 16 does not have a fixed longitudinal position relative to the member “a”, and (2) cutting action is not caused by lifting of the cutter body 1.

Claims 1 and 8 of the present application recite (1) a cutter knife fastened to an external longitudinal member, (2) a fixed longitudinal relationship between the cutter knife and the external longitudinal member, and (3) a cutter knife forced through the external longitudinal member by a cutter body upon lifting of the cutter body relative to the cutter knife. Neither Jenkins nor Liady discloses or even suggests these claimed features.

Consequently, claims 1 and 8 avoid a prima facie showing of obviousness with respect to the cited combination of references. Because claims 2, 3, 4, 9, and 10 either directly or indirectly depend on claim 1 or claim 8, they also are distinguishable over the cited combination of references.

The Applicants respectfully submit that claims 1 through 10 are patentable, and that the application is now in a condition for allowance. An early Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at (360)599-2285 for any reason that would advance the instant application to issue.

Dated this 11<sup>th</sup> day of July, 2005.

Respectfully submitted,



A handwritten signature of Gerald W. Spinks in black ink.

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CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

I hereby certify that this Response to Office Action is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria VA 22313-1450, on this, the 11<sup>th</sup> day of July, 2005.

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